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09/754,155	01/04/2001	Frank L. Weil	P5410	3195
32658	7590	11/02/2004	EXAMINER	
HOGAN & HARTSON LLP ONE TABOR CENTER, SUITE 1500 1200 SEVENTEEN ST. DENVER, CO 80202			CHEN, CHONGSHAN	
			ART UNIT	PAPER NUMBER
			2162	

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/754,155	WEIL ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Chongshan Chen	2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 19 July 2004.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 and 22-24 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) <b>®</b>                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### *Response to Arguments*

1. The declaration filed on 19 July 2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the Hendren reference (International Publication Number: WO 00/51031).

First, the declaration is defective because the declaration is not signed by all the inventors [See MPEP 704, 715].

Second, applicants are relying on actual reduction to practice prior to the reference date to antedate the reference. In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose [MPEP 715.07]. However, no such evidence has been supplied.

Moreover, applicants rely on various written descriptions to prove reduction to practice. Written description alone does not constitute an actual reduction to practice. Because applicants rely solely on the documents describing the invention, no reduction to practice has been shown. Note, that such documentation may support conception.

Furthermore, a general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23. 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is replying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice “amounts essentially to mere pleading unsupported by proof or a showing of facts” and, thus does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F2d at 718-19. 184 USPQ at 33. See also *In re Harry*, 33 F2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit “asserts that facts exist but does not tell what they are or when they occurred.”) [MPEP 715.07].

The declaration submitted by the applicants are just a general allegation that the establish conception and reduction to practice of the invention prior to the Hendren reference. Applicants do not point out any concrete evidence in the declaration for the claimed invention. For example, the limitations “creating a modified search request by applying a search profile for the client to the received search request”, “wherein the applying of the search profile includes adding at least a portion of the search profile to the received search request ...” in the claim 1 are not mapped to corresponding portions of the applicants’ submitted declaration and the examiner does not find sufficient support in the declaration for the aforementioned claim limitations. Therefore, the declaration is ineffective to overcome the Hendren reference.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 1-3, 23 and 24 are rejected under 35 U.S.C. 102(a) as being anticipated by

Hendren et al. ("Hendren", International Publication Number: WO 00/51031).

As per claim 1, Hendren teaches a method for controlling access provided to a client to content files during an information search based on a client search profile, comprising:

receiving a search request from a client (Hendren, Fig. 3A, 301, HTTP Request Received);

creating a modified search request by applying a search profile for the client to the received search request (Hendren, Fig. 3A, 303, Inset User Profile in Request); and

routing the modified search request to a search engine having a search engine collections populated from the content files (Hendren, Fig. 3A, 304, Forward Request to HTTP Server);

wherein the applying of the search profile includes adding at least a portion of the search profile to the received search request to specify a set of the search engine collections to be searched by the search engine with the modified search request (Hendren, page 2, "User profile information may be added to the data request ...").

As per claim 2, Hendren teaches all the claimed subject matters as discussed in claim 1, and further teaches the creating of the modified search request includes generating the search

profile based on stored information pertaining to the client (Hendren, Fig. 3A, 300, Establish User Profile Data).

As per claim 3, Hendren teaches all the claimed subject matters as discussed in claim 1, and further teaches the generating includes accessing the stored client information using login information for the client, the login information being collected prior to the receiving of the search request (Hendren, page 3, "Login data ...").

As per claim 23, Hendren teaches all the claimed subject matters as discussed in claim 1, and further teaches the modified search request comprises the received search request and the portion of the search profile included as an add on restriction (Hendren, Fig. 3A, 303, page 2-4).

As per claim 24, Hendren teaches all the claimed subject matters as discussed in claim 23, and further teaches the add on restriction is a tag label of one of the search engine collection (Hendren, Fig. 2B, element 254, the ZipCode and ParentalControl restrict the search area).

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 4-5 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendren et al. ("Hendren", International Publication Number: WO 00/51031).

As per claim 4, Hendren teaches all the claimed subject matters as discussed in claim 1, except for explicitly disclosing receiving a set of search results in a format defined by the search engine and including standardizing the set of search results. However, it is important to note that Hendren's search system is used in a Web server environment and uses Hypertext Transfer Protocol (HTTP) to carry requests from a browser to a web server and to transport pages from web servers back to the requesting browser (Hendren, page 4, lines 25-27, Fig. 3A, element 301, HTTP request received, element 304, Forward request to HTTP server). Applicant should note that the search system as disclosed by Hendren which uses HTTP and web browser to transmit and display search result has the capability of converting the search results into a HTML format, which is a standard format for transmitting and displaying the search result to the specified user (Hendren, page 6, lines 15-28, HTTP and web browser are used to transmit and display formatted HTML pages). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hendren's system by incorporating in the search system the use of providing to the user the search result in a HTML format in order to provide user the enhanced capability of uploading the search result, thereby allowing user to efficiently view the search result.

Claim 5 is rejected on grounds corresponding to the reasons given above for claim 4.

As per claim 14, Hendren teaches a Web server for controlling access to content files during a network-based information search initiated by a remote client, the Web server being communicatively linked to a search engine with search engine collections and the content files, comprising:

a Web server application in communication with a data communications network configured for communicating with the communications network and for receiving a search request from the remote client (Hendren, Fig. 1); and

add a client search profile to the search request to define select collections in the search engine collections for applying the search request and for routing the processed search request to the search engine (Hendren, Fig. 3A, 303, Insert User profile in Request, page 2).

Hendren does not explicitly disclose a search engine interface. Applicant should note, an interface is a hardware or software component that connects two or more other components for the purpose of passing information from one to the other (IEEE 100, "The Authoritative Dictionary of IEEE Standards Terms"). Hence, the search system of Hendren has a search engine interface between the client and the search engine, which allows a user to enter search request to the search engine in turn the search engine forward the search result through the use of the user interface for displaying and viewing.

As per claim 15, Hendren teaches all the claimed subject matters as discussed in claim 14, and further teaches the Web server is a HTTP Web server configured to support Java<sup>TM</sup> and the search engine interface comprises a Java<sup>TM</sup> API (Hendren, page 4, HTTP server).

As per claim 16, Hendren teaches all the claimed subject matters as discussed in claim 14, except for explicitly disclosing the search engine interface is further adapted parsing a set of

search results returned by the search engine in response to the routed search request to generate a standardized set of search results. It is important to note that Hendren's search system is used in a Web server environment and uses Hypertext Transfer Protocol (HTTP) to carry requests from a browser to a web server and to transport pages from web servers back to the requesting browser (Hendren, page 4, lines 25-27, Fig. 3A, element 301, HTTP request received, element 304, Forward request to HTTP server). Applicant should note that the search system as disclosed by Hendren which uses HTTP and web browser to transmit and display search result has the capability of converting the search results into a HTML format, in which is a standard format for transmitting and displaying the search result to the specified user (Hendren, page 6, lines 15-28, HTTP and web browser are used to transmit and display formatted HTML pages). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hendren's system by incorporating in the search system the use of providing to the user the search result in a HTML format in order to provide user the enhanced capability of uploading the search result, thereby allowing user to efficiently view the search result.

Claim 17 is rejected on grounds corresponding to the reasons given above for claim 4.

7. Claims 6-13, 18-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendren et al. ("Hendren", International Publication Number: WO 00/51031) in view of Copperman et al. ("Copperman", 6,711,585).

As per claim 6, Hendren teaches all the claimed subject matters as discussed in claim 1, except for explicitly disclosing prior to the receiving of the search request, intercepting an indexing request from the search engine for a set of information from the content for the search engine collections and in response, returning to the search engine a modified form of the

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requested set of information. Copperman teaches prior to the receiving of the search request, intercepting an indexing request from the search engine for a set of information from the content for the search engine collections and in response, returning to the search engine a modified form of the requested set of information (Copperman, col. 16, lines 6-7, col. 31, lines 47-54).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to populate the search engine with the indexed content prior to receive the search request in the search system of Hendren because the indexing orders the document collection with keywords or reference notations for identification or location of those contents. The search engine operating on the index built from the document collection would improve the search speed because the search engine does not need to search the entire content of documents.

As per claim 7, Hendren teaches a method for restricting direct access to content files by a search engine and a client during an information search initiated by the client and performed by the search engine, comprising:

receiving at the search engine interface a search request from the client (Hendren, Fig. 3A, 301, HTTP Request Received); and

routing the search request to the search engine for use in searching the search engine collections (Hendren, Fig. 3A, Forward Request to HTTP Server).

Hendren does not explicitly disclose positioning a search engine interface between the client and the search engine, wherein the search engine interface is also positioned between the search engine and the content files. Applicant should note that an interface is a hardware or software component that connects two or more other components for the purpose of passing information from one to the other (IEEE 100, "The Authoritative Dictionary of IEEE Standards

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Terms"). Hence, the search system of Hendren has a search engine interface between the client and the search engine and the set of content file, which allows a user to enter search request to the search engine, the search engine retrieves desired documents from the set of content file and forwards the search result through the use of the user interface for displaying and viewing.

Hendren does not explicitly disclose receiving with the search engine interface an indexing request from the search engine for a set of information from the content files; operating the search engine interface to retrieve the set of information from the content files; modifying content in the set of information with the search engine interface; passing the modified set of information to the search engine for use in populating a search engine collections. Copperman teaches receiving with the search engine interface an indexing request from the search engine for a set of information from the content files; operating the search engine interface to retrieve the set of information from the content files; modifying content in the set of information with the search engine interface; passing the modified set of information to the search engine for use in populating a search engine collections (Copperman, col. 16, lines 6-7; col. 31, lines 47-54). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to populate the search engine with the indexed content prior to receive the search request in the search system of Hendren because the indexing orders the document collection with keywords or reference notations for identification or location of those contents. The search engine operating on the index built from the document collection would improve the search speed because the search engine does not need to search the entire content of documents.

As per claim 8, Hendren and Copperman teach all the claimed subject matters as discussed in claim 7, and further teach the modifying includes removing metatags from at least a portion of the set of information (Copperman, col. 16, lines 6-7, col. 31, lines 47-54).

As per claim 9, Hendren and Copperman teach all the claimed subject matters as discussed in claim 7, and further teach the modifying includes adding additional information to the set of information (Copperman, col. 16, lines 6-7, col. 31, lines 47-54).

As per claim 10, Hendren and Copperman teach all the claimed subject matters as discussed in claim 7, and further teach the received search request includes a client search profile defining select collections in the search engine collections for applying the search request (Hendren, Fig. 3A, 302, 303, page 2).

As per claim 11, Hendren and Copperman teach all the claimed subject matters as discussed in claim 7, and further teach modifying the search request by operating the search engine interface to add a client search profile to the received search request to identify select ones of the search engine collections for applying the search request (Hendren, Fig. 3A, 302, 303, page 2).

As per claim 12, Hendren and Copperman teach all the claimed subject matters as discussed in claim 11, and further teach the modifying includes generating the client search profile including retrieving with the search engine interface user information for the client (Hendren, Fig. 3B, page 3).

As per claim 13, Hendren and Copperman teach all the claimed subject matters as discussed in claim 7, except for explicitly disclosing the positioning includes constructing an instance of the search engine interface that is configured for communicating with the search

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engine. Applicant should note that an interface is a hardware or software component that connects two or more other components for the purpose of passing information from one to the other (IEEE 100, "The Authoritative Dictionary of IEEE Standards Terms"). Hence, the search system of Hendren has a search engine interface between the client and the search engine, which allows a user to enter search request to the search engine in turn the search engine forward the search result through the use of the user interface for displaying and viewing.

Claim 18 is rejected on grounds corresponding to the reasons given above for claim 7.

As per claim 19, Hendren and Copperman teach all the claimed subject matters as discussed in claim 18, and further teach generate the search profile based on client information (Hendren, Fig. 3A, 300, Establish User Profile Data).

As per claim 20, Hendren and Copperman teach all the claimed subject matters as discussed in claim 18, and further teach receive a set of search results from the search engine and to parse the set of search results into a standardized set of search results for inclusion in a results page (Hendren, Fig. 1).

As per claim 22, Hendren teaches a method for concurrently restricting direct access to content files by a search engine and a client during an information search initiated by the client and performed by the search engine, comprising:

receiving at the search engine interface a search request from the client (Hendren, Fig. 3A, 302, HTTP Request Received);

modifying the search request to add a particular service identification defined in a client search profile (Hendren, Fig. 3A, 303, Insert User Profile Request);

routing the modified search request to the search engine for use in searching the search engine collections, whereby the search engine compares the particular service identification to the service identifications to select a subset of the search engine collections for use in the searching (Hendren, Fig. 3A, 304, Forward Request to HTTP Server).

Hendren does not explicitly disclose positioning a search engine interface between the client and the search engine, wherein the search engine interface is also positioned between the search engine and the content files. Applicant should note that an interface is a hardware or software component that connects two or more other components for the purpose of passing information from one to the other (IEEE 100, "The Authoritative Dictionary of IEEE Standards Terms"). Hence, the search system of Hendren has a search engine interface between the client and the search engine and the set of content file, which allows a user to enter search request to the search engine, the search engine retrieves desired documents from the set of content file and forwards the search result through the use of the user interface for displaying and viewing.

Hendren does not explicitly disclose receiving with the search engine interface an indexing request from the search engine for a set of information from the content files; operating the search engine interface to retrieve the set of information from the content files; modifying the retrieved set of information with the search engine interface to include service identifications; passing the modified set of information to the search engine for use in populating a search engine collections. Copperman teaches receiving with the search engine interface an indexing request from the search engine for a set of information from the content files; operating the search engine interface to retrieve the set of information from the content files; modifying the retrieved set of information with the search engine interface to include service identifications; passing the

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modified set of information to the search engine for use in populating a search engine collections (Copperman, col. 16, lines 6-7, col. 31, lines 47-54). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to populate the search engine with the indexed content prior to receive the search request in the search system of Hendren because the indexing orders the document collection with keywords or reference notations for identification or location of those contents. The search engine operating on the index built from the document collection would improve the search speed because the search engine does not need to search the entire content of documents.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chongshan Chen whose telephone number is (571)272-4031.

The examiner can normally be reached on Monday - Friday (8:00 am - 4:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (571)272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CC

October 26, 2004



JEAN M. CORRIELUS  
PRIMARY EXAMINER